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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Guido Baumoeller

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EXAMINER

FORTUNA, JOSE A

ART UNIT

PAPER NUMBER

1791

MAIL DATE

DELIVERY MODE

01/09/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/913,378	Applicant(s) BAUMOELLER ET AL.	
	Examiner José A. Fortuna	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/17/08.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10,11,13 and 16-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-11, 13, 16-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 10-11, 13 and 16-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. The term "quickly" in claims 10, 28, 31 and 34 is a relative term which renders the claim indefinite. The term "quickly" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The term quickly is a relative term that has not been defined in the specification, as to what is to be considered quick penetration and therefore, the metes and bounds of patent protection desired cannot be ascertained.

Claims 13 and 21 are improper, because they dependent in previously cancelled claims, claims 12 and 14.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 10-11, 13 and 16-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over de Haut et al (6,207,014).

This rejection is made based in the fact that the term “quickly” has not been well defined, see the rejection under 35 U.S.C. §112, 2nd paragraph above, and therefore, any penetration of the lotion would be considered as “quickly.”

Regarding claims 10-11, 13 and 16-35, de Haut et al. disclose the impregnation of paper with an aqueous softening lotion. The lotion contains the following components (last paragraph of column 5):

- a) 35-95% fatty alcohol

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- b) 1-50% waxy esters having a total of 24-48 carbon atoms
- c) Up to 20% nonionic/amphoteric emulsifiers
- d) Up to 50% mineral oil or wax.

The waxy esters are listed in column 2, lines 27-32 and include the ones recited in present claim 13. The preferred amount of emulsifier is 1.5 -5%, wax is 1-10% see column 8, lines 50-65.

One of the preferred non-ionic polyol emulsifier is in particular polyglycerol poly-12-hydroxystearate, column 7, lines 60-62.

Even though the claims recite the semi-open transitional phrase “consisting essentially of,” it is the examiner’s opinion that the use of saturated fatty alcohols would not materially change the composition and therefore, the cited reference still reads on the claims. Note that it has been held that “[I]f an application contends that additional steps or materials in the prior art are excluded by the recitation of “consisting essentially of,” applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant’s invention. *In re De Lajarte*, 337 F .2d 870, 143 USPQ 256 (CCPA 1964). It is applicant’s burden to establish that a step practiced in a prior art method is excluded from his claims by consisting essentially of language. *Ex parte Hoffman*, 12 USPQ2d 1061, 1063-64 (Bd. Pat. App. & Inter. 1989). Thus, at the very least, it would have been obvious to select those components and amounts, which de Haut et al considered to be preferred over other listed components. Therefore one of ordinary skill in the art would have selected the preferred amount of wax and the polyglycerol poly-12-hydroxystearate the non-ionic emulsifier.

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Regarding claims 28-35, even though de Haut et al. prefer the use of saturated waxy esters to avoid potential odor problems that some of the unsaturated waxy esters could cause, that in any way teaches away from using unsaturated waxy esters. One of ordinary skill in the art would have reasonable expectations of success if unsaturated ester are used, and can chose if so desire to use unsaturated esters which either: a) won't cause odor problem or b) would use some countermeasure to the odor problem, i.e., using perfume or odor repellent agent. It has been held that "[R]eferences are not limited to preferred embodiments." *In re* Boe, 148 USPQ 507 (CCPA 1966). Also, it has been held that all the disclosure in a reference must be evaluated for what they fairly teach one of ordinary skill in the art. *In re* Smith, 32 CCPA 959, 148 F.2d 351, 65 USPQ 167; *In re* Nehrenberg, 47 CCPA 1159, 280 F.2d 161, 126 USPQ 383; and in *In re* Watanabe, 50 CCPA 1175, 315 F.2d 924, 137 USPQ 350.

As to the moist feel, the cited reference teaches that the dry feels refers to the greasy sensation rather than moisture, see column 4, lines 54-59. Therefore, the moist limitation is also inherent to the reference.

Note, also that the degree of penetration of the lotion has not been defined, i.e. complete or partial or up-to what point of the thickness of the web, and the lotion of the cited reference would penetrate at some degree part of the web, i.e., not all of the lotion would stay at the surface, but it would go through part of the thickness of the web. This happens even if the penetration is not desired for several reasons, e.g., some of the particles of the emulsion are fine enough to go through the pores of the web and are sucked by capillary action, etc.

Response to Arguments

8. Applicant's arguments with respect to claims 10-11, 13 and 16-35 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure in the art of "Process of Making Soft Papers."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to José A. Fortuna whose telephone number is 571-272-1188. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/José A Fortuna/
Primary Examiner
Art Unit 1791

JAF